

REMARKS

Favorable consideration and allowance are respectfully requested for claims 9-14 in view of the following remarks and the attached Declaration.

The Office Action indicated that claims 12-14 are allowed for reasons of record in the Office Action mailed February 3, 2003. Applicant thanks the Examiner for his thorough review and consideration of these claims, and submits that these claims are allowable for at least the reasons cited in the Office Action mailed February 3, 2003.

Rejection Under 35 U.S.C. § 102(b)

Claims 9-11 were rejected under 35 U.S.C. § 102(b) in view of Sakata, et al. (JP 09124652). This rejection is respectfully traversed.

The Sakata reference teaches a porphyrin compound as a mixture of position isomers and that the mixture is useful for photodynamic treatment and diagnosis of cancer. As explained below, there is no teaching or suggestion of any single isomer in the Sakata reference. Further, the claimed isomeric compound possesses unobvious and unexpected beneficial properties not possessed by the mixture taught by Sakata.

As explained in the attached Declaration of Yoshinori Nakae (the Declaration), Mr. Nakae conducted an experiment to compare the accumulability in cancerous tissues of the porphyrin compound claimed in the present application (Compound I) with that of the isomeric mixture porphyrin compound

of the Sakata reference. See paragraph 2 of the Declaration. The results of the experiment are depicted graphically in Appendix A to the Declaration.

These results clearly show that the accumulability of the claimed porphyrin compound, Compound I, is significantly higher than that of the isomeric mixture taught by the Sakata reference. See paragraphs 7 and 8 of the Declaration.

This significantly higher accumulability is an unexpected beneficial property of the claimed compound and could not have been predicted based on the Sakata reference. Sakata provides no teaching, suggestion or motivation to one of skill in the art to try the claimed compound in order to achieve greater accumulability.

The Office Action indicates:

a novel useful compound which is isomeric with a compound of the prior art is unpatentable unless it possesses some unobvious or unexpected beneficial property not possessed by the prior art compound (*In re Norris*, CCPA 1950, 179 F2d 970). Likewise, Applicant is reminded that an optically active isomer is unpatentable over a prior art racemate or optical isomer of opposite rotation in the absence of unexpected or unobvious beneficial properties (*In re Adamson et al.* CCPA 1960, 275 F2d 952).

Applying this test, the present claims are clearly allowable over the Sakata reference. The Declaration and the data presented in Appendix A thereof

show that the claimed invention has unobvious and unexpected beneficial properties, namely the greater accumulability in relation to the isomeric mixture of Sakata. This is achieved through the Applicant's novel and inventive use of the separated position isomer of the porphyrin compound.

Considering the foregoing, it is respectfully requested that the Examiner withdraw this claim rejection.

CONCLUSION

In view of the foregoing, the application is respectfully submitted to be in condition for allowance, and prompt favorable action thereon is earnestly solicited.

If there are any questions regarding this amendment or the application in general, a telephone call to the undersigned would be appreciated since this should expedite the prosecution of the application for all concerned.

Although a petition for an extension of time is submitted herewith, if necessary to effect a timely response, this paper should be considered as a petition for an Extension of Time sufficient to effect a timely response, and please charge any deficiency in fees or credit any overpayments to Deposit Account No. 05-1323 (Docket No. 010310.49996US).

Respectfully submitted,

Date: December 15, 2003

A handwritten signature in black ink, appearing to read "Chris McWhinney", with a long horizontal stroke extending to the right.

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